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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/829,511

04/22/2004

Rangarajan Sundar

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MEDTRONIC VASCULAR, INC
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SANTA, ROSA, CA 95403

EXAMINER

DOWE, KATHERINE MARIE

ART UNIT

PAPER NUMBER

3734

MAIL DATE

DELIVERY MODE

06/12/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/829,511	Applicant(s) SUNDAR, RANGARAJAN	
	Examiner KATHERINE M. DOWE	Art Unit 3734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 11-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/22/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 11-32 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 3/24/2008.
2. Claims 1-10 and 33 are currently under consideration.

Double Patenting

3. Claims 1-10 and 33 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 and 33 of copending Application No. 10/827,817. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter in the instant application is fully disclosed in the above copending application and would be covered by any patent granted on that copending application since the copending application and the instant application are claiming common subject matter including: a stent disposed on a balloon catheter where the stent comprises a stainless steel frame, an amino silane layer disposed on the stent, and a coating layer comprising a polymer and therapeutic agent disposed on the silane layer. Furthermore, there is no apparent reason why Applicant would be prevented from presenting claims corresponding to those of the instant application in the above copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968) and MPEP §804.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(f) he did not himself invent the subject matter sought to be patented.

5. Claims 1-10 and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Rypacek et al. (US 2003/0219562). Rypacek et al. disclose a stent disposed on a balloon catheter (¶0352). The stent comprises a stainless steel frame (¶0077), an amino silane layer (¶0022, 0031) disposed on the stent, and a coating layer disposed on the silane layer (¶0020). The coating layer comprises a polymer and therapeutic agent (¶0020, 0021, 0023).

6. Claims 1-10 and 33 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. The claimed subject matter is disclosed in Application 10/827,817 and related Provisional Application 60/464,612 (published as US 2004/0215313) naming Peiwen Cheng as the inventor. Cheng (US 2004/0215313) discloses a stent disposed on a balloon catheter where the stent comprises a stainless

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steel frame, an amino silane layer disposed on the stent, and a coating layer comprising a polymer and therapeutic agent disposed on the silane layer (§§0027, 0033, 0037, 0039).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Sirhan et al.	(US 2003/0083646)
Ruane et al.	(US 2007/0150047)
Ragheb et al.	(US 2003/0036794)
Falotico	(US 2004/0236416)
Lewis et al.	(US 2004/0117006)
Hossainy et al.	(US 2004/0162609)
Carlyle et al.	(US 2003/0204239)
Bates et al.	(US 2003/0028244)
Liu et al.	(US 7,341,756)
Rowland et al.	(US 5,356,433)
Pacetti et al.	(US 6,663,662)

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KATHERINE M. DOWE whose telephone number is (571)272-3201. The examiner can normally be reached on M-F 8:30am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kevin T. Truong/
Primary Examiner, Art Unit 3734

Katherine Dowe
June 5, 2008

/K. M. D./
Examiner, Art Unit 3734